

REMARKS

Status of Claims

The Office Action mailed September 29, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-28 were pending in the application. Claims 1, 19, 27, and 28 have been amended, no claims have been canceled or newly added. Therefore, claims 1-28 are pending in the application and are submitted for reconsideration.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Prior Art Rejections

In the Office Action, claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 are rejected under 35 U.S.C. § 102(a) as being anticipated by ediconsulting.com (hereafter “Ediconsulting.com”). Claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over ediconsulting.com in view of U.S. Patent No. 5,913,210 to Call (hereafter “Call”), U.S. Patent No. 5,862,325 to Reed et al. (hereafter “Reed”), and U.S. Patent No. 6,408,292 to Bakalash et al. (hereafter “Bakalash”). Applicants respectfully traverse these rejections for at least the following reasons.

Each of the independent claims 1, 19, 27, and 28 recite a method (or system/software) for automatically determining EDI products and services to allow a user (of a hub) to efficiently perform EDI with a plurality of trading partners. Therefore, these claims recite, *inter alia*, an automated method (and corresponding software application and database) that allows automatic determination of suitable EDI products or services for performing EDI with each of a plurality of selected trading partners. These recited features are not disclosed or suggested by the applied prior art.

Specifically, nowhere does Edisonconsulting.com disclose or suggest this automated determination by a host server of the suitable EDI products and services that are needed to perform EDI with a plurality of selected trading partners. The cited web pages performing EDI *evaluations*, mapping *support*, Ongoing *support* for outsourced EDI, and *Systems*

Integration all of which are well known in the art as being descriptive of largely manual custom integration, support, and testing for clients. Therefore, to the extent that this reference is relevant to the claimed invention, it teaches away from the claimed invention recited in the pending claims since the process taught by Edisonconsulting.com requires the use of their experts with specialized knowledge and all the attendant disadvantages related to hiring and depending on such experts.

With respect to the anticipation rejection, the office action acknowledges that Edisonconsulting.com is “silent on a database of information on a plurality of hub trading partners,” and relies on inherency for this recited feature. It should be noted that “[t]he fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result of characteristic.” *See In re Rijcskaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (also cited in MPEP § 2112). Furthermore, as noted in MPEP § 2112, “Inherency, however, may not be established by probabilities or possibilities.” Therefore, when a recited feature in the independent claims is not disclosed in the applied prior art, anticipation is improper and this rejection of the independent claims should be withdrawn.

Furthermore, as discussed above, the independent claims recite an automated method (and system/software) that automatically selects (at a host server) the suitable EDI products and services for each of a potentially a vast number of selected EDI trading partners so that EDI with each of the selected EDI trading partners (with their own requirements and products) can be efficiently performed. One of the advantages of the claimed method and system is that it eliminates or reduces the need for the custom system integration and mapping services by an “expert” as offered the Edisonconsulting.com reference. Therefore, not only does Edisonconsulting.com not disclose the features recited in the pending claims, it teaches away from the claimed invention by requiring custom solutions and expertise in sharp contrast to the claimed automated determination recited in the pending claims.

Furthermore, the deficiencies of Edisonconsulting.com are not cured by any of the other applied references. Therefore, neither the specific recited features nor their advantages are disclosed or suggested by the applied prior art. Accordingly, the pending independent claims are patentable over the applied prior art.

The dependent claims are also patentable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

For example, claims 11 and 25 recite automatically generating and sending a message to a sales channel to follow up in providing the electronic commerce products or services required by the user to perform EDI with the selected EDI trading partners. Such an automated follow up in the context of providing EDI products or services (products or services that facilitate EDI) is also not taught or suggested by the applied prior art and provides an additional reason for the patentability of these claims.

Conclusion

In view of the foregoing amendments and remarks, applicants respectfully submit that the application in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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FOLEY & LARDNER LLP
CUSTOMER NO. 22428
Telephone: (202) 672-5485
Facsimile: (202) 672-5399

By Aaron C. Chatterjee

William T. Ellis
Registration No. 26,874
Aaron C. Chatterjee
Registration No. 41,398
Attorneys for Applicants